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Walter Otto Repple

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EXAMINER

WEINSTEIN, LEONARD J

ART UNIT

PAPER NUMBER

3746

MAIL DATE

DELIVERY MODE

09/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. This action is in response to applicant's amendment of April, 25, 2008 responding to the restriction requirement of February 25, 2008.

Priority

2. The instant application is a US national stage application (of PCT/CA03/02017) claiming foreign priority to a US non-provisional application (10/330108). A US non-provisional application is not a "foreign application" within the meaning of 35 USC 119(a) and 365(b) and 37 CFR 1.55.

a. A national stage application may claim priority under 35 USC 119(a) and 365(b) based on a prior foreign application or international application designating at least one country other than the US.

b. 35 USC 365(b) provides that an international application designated the US "shall be entitled to the right of priority based on a foreign application," or a prior international application designating at least one country other than the US.

c. 37 CFR 1.55 provides that an applicant in a non-provisional application may claim the benefit of the filing date of one or more prior foreign application under 35 USC 119(a)-(d) and (f), 172, and 365(a) and (b).

3. The applicant must submit a benefit claim under 35 USC 120 and 365(c) and 37 CFR 1.78 in order to claim the benefit of the US prior-filed non-provisional application. Under 37 CFR 1.78:

- 37 CFR 1.78.(a)(2)(i) –

Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United

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States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

- 37 CFR 1.78.(a)(2)(ii)

This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (A) An application for a design patent;
- (B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or
- (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

- And 37 CFR 1.78.(a).(3) -

If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) The surcharge set forth in § 1.17(t); and
- (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was

filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

4. The applicant cannot file a claim to the prior US application under 119(a) as a claim to a foreign priority. A proper benefit claim under 35 USC 120 and 365(c) and 37 CFR 1.78 was required to be filed within the later of four months from the date of on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application (June 20, 2005), or sixteen months from the filing date of the prior-filed application (December 30, 2002). Since a proper benefit claim has not been submitted to date and the instant application does not fall into one of the groups in 37 CFR 1.78(a)(2)(ii)(A-C), a petition subject to the provision in 37 CFR 1.78.(a).(3) for a benefit claim under 35 USC 120 and 365(c) must be filed with this office.

Response to Amendment

5. The amendment is deemed to be unresponsive for the reasons set forth below however in addition to this the application improperly claims priority US application 10/330108 under 35 USC 119(a) and 365(b) based on a prior foreign application or international application designating at least one country other than the US.

6. Applicant's arguments that the PTO is "forbidden under PCT Art 27(1), from requiring compliance with requirements relating to the contents of the international application different from or additional to those provided in the PCT," and the "US PTO... is now barred from imposing further or unilateral lack-of-unity objections" are noted.

a. The applicant's argument citing PCT Article 27 is noted however the examiner urges the applicant to revisit Article 27 subsection (5) which states:

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“Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.”

- b. The applicant's argument asserting that the PTO is barred from imposing an lack of unity objection is noted however the examiner notes that MPEP

1893.03(d) states:

“37 CFR 1.499. Unity of invention during the national stage If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner.”

- c. As such the examiner was not barred under PCT Article 27(1) since PCT Article 27(5) allows each contracting state to apply the criteria of its national law conditions of **patentability** not constituting form and contents of applications. Claims 1 and 31 are patentably distinct and do not share a common technical feature. A determination and objection for lack of unity does not constitute an objection to the form and content of the application rather it is directly related to the patentability of the invention claimed. The examiner did not exercise a restriction on the instant application pursuant to US restriction practice under 37 CFR 1.141-1.146. However the examiner did conclude that the inventions of Group 1 and Group II lacked unity and pursuant to 37 CFR 1.499, required the applicant to elect one invention, as permitted by Article 27 (5).

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d. In light of the statements in items a and b of this section the examiner was not prohibited from raising a lack of unity objection and upholds the objection on the grounds that follow. The inventions of Groups 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

i. The invention of Group 1 is drawn to a coolant pump comprising a set of swirl vanes, a radiator port, and a radiator port closer provided within a pump chamber and the invention of Group 2 is drawn to a coolant pump comprising an impeller having two sets of blades including a primary set of blades orientated in an axial direction and a set of secondary blades orientated in a radial direction.

ii. The invention of Group 1 requires an impeller but does not require an impeller to include first and second sets of blades that are orientated in an axial and radial direction respectively.

iii. The invention of Group 2 does not require among other major elements of invention of claim 1, a radiator-port-closer, a rad-port-driver, or a set of swirl vanes. The invention of Group 2 is essentially directed toward an impeller that is not required by the invention of claim 1 and has separate utility as a pumping member in a multitude of different rotary non-expansible chamber type pumps.

7. The reply filed on April 25, 2008 is not fully responsive to the prior Office action because of the following omission(s) or matter(s): applicant failed to elect the single invention of either group I or II identified in the requirement for restriction on February 25, 2008. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona*

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vide, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. Since this application has been granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR 1.136(a) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Response to Arguments

8. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the unresponsive amendment filed by the applicant.

9. For the purpose of furthering prosecution the examiner feels it necessary to respond to the applicant's arguments as follows.

a. Applicant's comments regarding the statements in the requirement for restriction of February 25, 2008 directed toward the prospect of claims being subject to rejection under 35 U.S.C. 101 as being a "threat," are unfortunate and unnecessarily adversarial.

i. The examiner raised the issue of double patenting to support the species restriction set forth in the action of February 25, 2008. In order to

conduct a species restriction in a case where an application has entered into the National stage, the examiner must show that the novelty of an invention resides in the dependent claims directed toward different embodiments disclosed in the application. For this reason the examiner referred to the claims that would be subject to a rejection on the grounds of nonstatutory obviousness-type double patenting to establish that the novelty of the invention did not reside in independent claim 1. Rather the dependent claims, which were directed to different species that comprised of specific features that were not common to all of the claims, satisfied the determination that under PCT Rule 13.2 the species lacked the same or corresponding special technical feature. Therefore a single general inventive concept under PCT Rule 13.1 was not claimed. The examiner assures the applicant that this is a proper grounds for lack of unity and the standard discussed above and in detail in the office action of February 25, 2008 correctly describes the equivalent for a PCT to the US practice of election of species.

ii. The applicant is correct in that a species restriction is not proper in this case because the prior art that was relied on to establish that novelty was lacking in the independent claim was not available as prior art and this cannot be established with a double patenting rejection of the claim. Since there was not a proper benefit claim for priority the examiner could have used the publication of the application 10/330108 as prior art if it had

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been by another and thus fall within the confines of 102(a). The published application and the instant application have the same inventors and published application is not available under 102(a). The examiner incorrectly attempted to establish that the claim 1 of the instant application did not contain an inventive concept and that novelty was established only in the dependent claims in the instant application. Although this was not an argument raised by the applicant the requirement for restriction based on election of species has been withdrawn.

b. The applicant argues that 35 U.S.C. 101 does not suggest that a difference between claims of prior filed **US** application (10/330108) and instant application cannot lie in broadening of the claims in the instant application. The examiner addresses this argument in light of the unique situation that has been created by applicants benefit claim to a foreign application that is a **US** application. The applicant's argument could carry weight if the foreign application was indeed a foreign application, because it is conceivable that a claim would not require all the limitations of the original application to receive a patent in a country other than the country which the application was originally filed. An applicant would not be barred from perfecting their application as long as support for any changes to the claims could be found in the foreign (original) application. In this case the original application is not a foreign application and it is clear why there would be an issue if an application that claimed benefit under 35 U.S.C. 120 had broader limitations in its independent claim than the

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limitations of the independent claim(s) of the prior filed **US** application. The subject matter of the narrower limitations of the prior filed **US** application would have already been (at least substantially) presented, published and patented in this country.

c. The applicant argues that examiner's comments in the action of February 25, 2008, that the limitations of the instant application are not the same as those of claim 1 of the prior **US** application but both claim substantially the same invention, are contradictory. The examiner disagrees and asserts that it is not a contradiction to say that claim limitations are not exactly the same but do in fact substantially claim the same invention. The fact that the examiner qualified the statement by saying the inventions claimed were substantially the same implies that there was some degree of variance and the claims were not exactly the same. The examiner also asserts that it is possible, and readably conceivable, to recite claims which are not exactly the same but are substantially the same to the degree that the inventions claimed are not patentably distinct from one another.

d. The examiner's response to applicant's traversal of the determination of lack of unity can be found in item 6 of this office action.

e. The examiner's response to applicant's arguments regarding the requirement to elect a single species can be found in item 9.a.i and 9.a.ii of this office action.

f. With respect applicant's argument regarding the allowability of claim 1 and the request for the examiner to clearly enumerate the grounds for rejection under

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35 U.S.C. 101 non-statutory obvious type double patenting, the examiner declines to set forth a full rejection here in light of the issues that applicant must address for prosecution to continue. Applicant's amendment has been deemed unresponsive and further the applicant must present a petition to allow for a proper benefit claim under 35 U.S.C. 120. However following the last section before the conclusion of this office action the examiner has provided the grounds for rejection of claim 1 for the applicant's benefit.

10. The examiner now requests that in their response, the applicant specifically point to the sections of the prior **US** application (not the PCT) where support can be found for the limitations in claims 1-30. Initial review of the application 10/330108, the published version (US 2003/0143084) of application 10/330108, and the patent arising from application 10/330108, reveals that in the very least the prior **US** application does not provide support for the limitations of claims 2 and 9 of the instant application. Claims 2 and 9 of the instant application are the same as claims 2 and 9 in the international application (PCT/CA03/02017) and find support in paragraphs 110 and 65 of the international application respectively, however the subject matter of these claims cannot be found in the original **US** application.

The limitations of claims 2 and 9 (in very least) of the instant application would not be considered subject matter falling under a continuation of the original **US** application. In effect the applicant, as priority is currently claimed, would improperly receive the benefit of the priority date of the prior **US** application that does not support these claims and the patent term starting from the time when the instant application was

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effectively filed in this office (date of the PCT/CA02/02017). The subject matter of these claims is not supported by the original US application and should have been submitted under 35 U.S.C. 120 as part of a continuation in part of the original US application effective of the date of the international application which it is a national stage of.

The effect of the applicant setting forth limitations in claim 1, that with exception of a feature that would have been obvious to one having ordinary skill in the art, would essentially set forth broader limitations than those of an application that has already been patented. Further by claiming "foreign" priority some subject matter (such as claim 1) would receive the benefit of the filing date of the US application and the patent term beginning from the date the international application was filed instead of a patent term beginning from the date of the original US application. The since the patent and the application are claiming common subject matter the instant application would, if allowed, improperly extend the "right to exclude" already granted in the patent.

The overall effect of applicant's current application would be that some claims would improperly extend the applicant's right to exclude by extending the patent term for some subject matter common to the original US application because those claims would receive the more recent starting date for a patent term beginning from the date of filing of the international application. Conversely the applicant would also reap the benefit that some claims, such as that of claims 2 and 9, would properly receive a patent term with the start date of the filing date of the international application but improperly receive a benefit claim of priority to an application which did not disclose the subject matter of those claims. Upon a board of petition's decision to allow applicant to continue with

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prosecution and receive a benefit claim under 35 U.S.C. 120, assuming the applicant is able to establish that subsequent to 37 CFR 1.78(a)(3) the prior erroneous filing was unintentional, a request upon the applicant to identify the sections of the prior application (10/330108) which support the claimed limitations of claims 1-30, will be reiterated by the examiner if the applicant will not have already done so.

11. For the applicant's benefit a rejection of claim 1 follows:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,887,046 in view of Arnold US 2002/0187061 A1. The elements of claim 1 instant application are followed here with a reference number for the patent that includes the claim number and the paragraph of

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the claim number where the limitation of the instant invention is claimed by the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the application and the patent teach the combination set forth in the claims disclosing a coolant pumping apparatus (1-¶1), an apparatus with fixed walls (1-¶2), a motor driven impeller (1-¶3) that lies inside a pumping chamber (1-¶4), the walls of the pumping chamber include a radiator port (1-¶5), for communication between the pumping-chamber and a radiator, and the pump includes a mechanical radiator-port-closer (1-¶6), the radiator port moveable in a port closure mode (1-¶7), a radiator port thermal unit (1-¶12), a coolant temperature sensor, a fixed element and thermally movable element, and a radiator port driver (1-¶13-14), a set of swirl vanes (1-¶8), the swirl vanes arranged to impart a rotary swirl motion (1-¶9), a vane mounting structure (1-¶10), the swirl vanes further being mechanically movable in a vane orientation mode (1-¶11), and a vane orientation guide and swirl vane thermal unit with the limitations of the claim 2 which set forth that a thermal driver subsequently acts as the thermal unit for the swirl vane during operation. The prior patent does not claim the limitations that are taught by Arnold for a pump wherein a set of swirl vanes 22, a port 20, and a port closer 34 are located inside a pumping chamber. It would have been obvious to one having ordinary skill in the art at the invention was made to provide coolant pumping apparatus having a set of swirl vanes, a radiator port and a radiator port closer as taught in the prior patent, and modify the arrangement of these component such that each is arranged inside of pumping chamber, as taught by Arnold

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in order to improve the operation of the vanes and increase the efficiency of the pump (Arnold - ¶0010).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD J. WEINSTEIN whose telephone number is (571)272-9961. The examiner can normally be reached on Monday - Thursday 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on (571) 272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Devon C Kramer/
Supervisory Patent Examiner, Art
Unit 3746

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Examiner, Art Unit 3746